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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,310	02/01/2002	Paul C. Clark	176.0004CIP	8559

25534 7590 05/31/2006

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EXAMINER

PICH, PONNOREAY

ART UNIT PAPER NUMBER

2135

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/060,310	CLARK, PAUL C.	
	Examiner	Art Unit	
	Ponnoreay Pich	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-14 are pending. Applicant's amendments have been considered. The amendments change the scope of the claims and necessitate an election/restriction requirement, see below.

As a preliminary matter, the examiner notes that the examiner had an interview with applicant and applicant's representative concerning the current application on 12/15/2005. During the interview, the examiner noted that the Office had issued new guidelines for 35 USC 101 that the examiner had not yet had an opportunity to review at the time of the interview that may moot some of the 101 rejections in the prior Office action. The examiner has since reviewed these new guidelines and has considered the pending claims in light of these new guidelines. Applicant may wish to take note of what is stated below by the examiner and act accordingly in the response to the election/restriction requirement and take the opportunity to make any further amendment to overcome any still pending 101 rejections so that there is no delay in prosecution. Applicant may also wish to double check the amendments to the specification that was submitted to make sure applicant made the appropriate corrections as the examiner noted some paragraphs that applicant may have inadvertently forgotten to make necessary corrections or there may be new matter inadvertently added.

Regarding currently amended claim 1 and its dependent claims, the examiner believes that a withdrawal of the 101 rejection from the previous Office action would be proper because in light of the latest guidelines, there does not appear to be any 101

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issues with currently amended claim 1 or claim 1 from the prior Office action. The dependent claims of claim 1 also appear to be statutory. Regarding claim 6 and its dependent claims, the examiner notes that viewed in light of the latest guidelines, maintaining the previous Office action's 101 rejections would be proper since applicant's specification had defined a computer usable medium as a carrier wave. It is the Office's current view that signals, i.e. carrier waves, are not statutory subject matter. This view is the same as when the examiner first made the rejection in the prior Office action. The examiner notes that applicant's specification did not define a "computer readable storage medium" as a carrier wave and absent any disclosure as such, it is the Office's policy to assume that such a medium does not encompass a signal. Thus, applicant can make claims 6-10 statutory by amending the "computer usable medium" in claim 6 to instead be "computer readable storage medium". Applicant may also want to take the opportunity to modify the language used in the body of the claim such that the computer readable program code "causes" something to occur rather than it be "for causing" something to occur, which indicates intended use. Amending claim 6 as recommended to make it statutory would also make claims 7-10 statutory. As per claims 11-12, it is still the Office's view according to the latest 101 guidelines that apparatus and system claims that read on software entirely are not statutory. Since applicant discloses in the specification that a logical unit can be entirely software, the 101 rejections for claims 11-12 in the previous Office action would be properly maintained even when viewed according to the latest guidelines. Applicant must recite

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at least one structure in claims 11 and 12 that is at least partly hardware (without an entirely software alternative) for claims 11 and 12 to be statutory.

Note that the examiner's statements above are not to be construed as the examiner issuing a complete Office action and that any search has been performed for the pending claims or that there is any allowable subject matter since no rejections are made. In fact, no updated search has yet been performed by the examiner. The examiner is merely giving applicant an opportunity avoid any possible delays in prosecution due to 101 problems, which we were not able to fully discuss during the last interview, should an updated search after an election of an invention is made indicate any allowable subject matter.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 13, drawn to a method and article of manufacture to used to identify encrypted data transmission and whether a sender is authorized to perform the encrypted data transmission, classified in class 713, subclass 182.
- II. Claims 11-12 and 14, drawn to a logical unit and logical system comprising a processor having a plurality of proxies, classified in class 726, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in

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scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as securing communication between two domains by ensuring that the transmission from one domain to the other is recognized and that the sender of the transmission is recognized. Subcombination II has separate utility such as facilitating communications between domains via the use of a processor or logical unit having multiple proxies. In subcombination II, there is no need to verify that the transmission is recognized as in subcombination I. In subcombination I, there is no need to use a processor or logical unit having multiple proxies as in subcombination II. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Frederick Samuels on 5/26/2006 to request an oral election to the above restriction requirement, but did not result in an election being made. The examiner called Mr. Samuel's office and was informed that Mr. Samuels was out of the office for the day. Because the examiner was unable to contact Mr. Samuels to get an oral election before the examiner's deadline to act on applicant's response submitted on 3/22/2006, the examiner regretfully has to submit this election/restriction requirement via an Office action.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich
Examiner
Art Unit 2135



10/11/11
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100